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Reply Brief

CASE PH/58-19848/A/PCT/CONT

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Sharon K. Waynick	Sharon K. Waynick	January 12, 1999
Type or print name	Signature	Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
JALETT ET AL.
APPLICATION NO: 08/926,835
FILED: SEPTEMBER 10, 1997
FOR: PROCESS FOR THE HYDROGENATION OF IMINES

Art Unit: 1621
Examiner: S. Kumar

Assistant Commissioner for Patents
Washington, D.C. 20231

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REPLY BRIEF

Sir:

This Reply Brief is responsive to the Examiner's Answer of November 12, 1998:

(1) The Disclosure of Osborn U.S. Patent 5,112,999

The various examples of Osborn neither teach addition of an acid nor addition of a catalyst with ligands that contain an $-SO_3H$ substituent. The disclosure in column 1, lines 55-60 clearly reads on the **catalyst**. It is a mere assumption of the Examiner, without giving any evidence, that the catalyst should be an acid. The disclosure in column 6 and 7, bridging paragraph as well as all the examples are limited to teach an **organic reaction medium**. The Examiner speculates as to liberation of acid in the Osborn reaction (page 5, line 1), which is impossible under the given reaction conditions (since no water is present to form an acid). Appellants emphasize that additional use of an acid in the context of the instant invention means an **aqueous acidic solution**.

The Examiner has not provided any evidence of how and that acid is liberated from the Osborn teaching. Accordingly, the Osborn disclosure is insufficient to support a rejection under § 102. Moreover, there is no reasonable expectation of success in achieving any liberation of acid

based on any modification of Osborn which either is suggested from Osborn alone or in any combination with the secondary references. Accordingly, the record is insufficient to support a rejection under § 103.

(2) The Examiner's Notice Of Facts Outside The Record

The Examiner has states that: (i) "one of ordinary skill knows that [a] loop reactor is known in the chemical art"; and (ii) the prior art teaches *in situ* generation or liberation of acid.

Appellants traverse the any rejection of the claims based thereon in particular hereby traverse the statement made by the Examiner and the Examiner's taking official notice of facts outside the record. The scope of Examiners statement is over-broad and nonspecific as to the claims at issue. It is not clear that there would be documentary evidence to support such a broad statement. The Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. M.P.E.P. § 2144.04. The Examiner's statement can not be instantly and unquestionably substantiated by documentation in the art to which the instant invention pertains. Appellants are unaware of any teachings in a reference made of record that could be reasonably cited to support the Examiner's propositions.

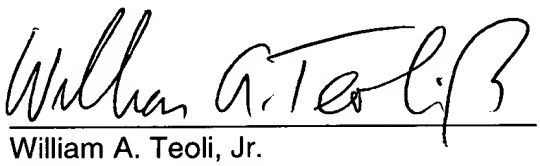
Also, the Examiner has improperly taken official notice of a critical feature of Appellants' claimed invention ("additionally containing an acid"). Case law precedent indicates that at least with regard to judicial notice the facts so noticed serve to "fill the gaps" which might exist in the evidentiary showing and should not comprise the principle evidence upon which a rejection is based. See In re Ahlert, 165 U.S.P.Q. 418, 420-421 (CCPA 1970), In re Barr, 170 U.S.P.Q. 330 (CCPA 1971) and In re Eynde, 178 U.S.P.Q. 470 (CCPA 1973). M.P.E.P. §2144.03.

The Examiner has failed to make out a *prima facie* case of obviousness. The Examiner has not pointed out proper motivation and suggestion in the prior that would lead one of ordinary skill to modify the applied reference so as to obtain the instantly claimed invention. Nor has any basis been given to support the Examiner's speculation that acid is generated *in situ*. It is respectfully submitted that the Examiner's statement and taking of official notice thereof, was derived from and prompted by knowledge disclosed by Appellants and not by specific knowledge known in the relevant prior art, and therefore constitutes improper hindsight reconstruction. Reconsideration and withdrawal of the §§ 102 and 103 rejections are respectfully requested.

Based on the foregoing arguments and discussion, Appellants respectfully submit that the claims on appeal are both novel and unobvious over the cited prior art and that the §§ 102-103 rejections of the claims are in error as to fact and law and should be reversed.

If any fee under 37 CFR § 1.17 is due in connection with this Reply Brief, the Commissioner is authorized to charge Deposit Account No. 19-0134 for the appropriate amount.

Respectfully submitted,



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